

REMARKS/ARGUMENTS

Claim Rejections under 35 U.S.C. § 103

The office action states that Claims 1-9 are rejected under 35 U.S.C. § 103(a) as unpatentable over Wolf et al. (U.S. Patent No. 5,378,268) in view of Lane et al. (U.S. Patent No. 5,985,785), as evidenced by Univar. The office action states that Lane includes an anticaking agent like Cab-o-sil® to facilitate grinding of metal salts, and that Wolf intends the use of similar metal salt complexes. The office action reasons that it would therefore have been prima facie obvious to form the complex materials of Wolf after grinding with an anticaking compound of Lane to facilitate the complexing reaction and preserve large reactive surface areas of the metal salt. Moreover, the office action concludes, inclusion of the anticaking compound would lead to creation of a primer that had the same inherent properties as that claimed in the Application.

1. There is no motivation to combine the references.

Applicant respectfully disagrees with the finding of obviousness. It is well established that for an invention to be obvious in light of some prior art, all claim limitations of the invention must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, for obviousness to be established through a combination of references, there must be some motivation in the prior art to combine the references. This motivation may come either from the references themselves or from knowledge that is generally available to one skilled in the art. Motivation to combine references may not come from the disclosure of the application; such hindsight is impermissible. *See In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

There is no motivation in Lane for combination of the references. Although Lane does discuss grinding the metal salt of that invention to a fine powder while accompanied by an anticaking agent, there is no indication that doing so would be beneficial for the production of the primer described by Wolf. Furthermore, there is no motivation in either reference for the inclusion of any anticaking agent in the final product. Note, for instance, that neither Example 1 (column 10, line 35) nor Example 2 (column 11, line 19) of Lane mentions inclusion of an anticaking agent in the mixture of polymer and palladium acetate.

Wolf does not provide any motivation for combination with Lane. There is no mention in Wolf of the use of an anticaking agent. There is also no discussion in either Lane or Wolf to show that one skilled in the art would find that it is always (or even often) preferable to grind a metal salt in the presence of an anticaking agent when one contemplates future complexation of the metal salt.

Further indication of lack of motivation to combine the references is evidenced when one considers that Wolf makes no mention of use of an anticaking agent, even though other "auxiliaries and additives" are discussed as suitable for possible inclusion in the film or matrix former of that invention. For instance, Wolf mentions the optional inclusion of catalysts, emulsifiers, stabilizers, and reaction retarders, but it does not disclose anticaking agents. (Column 11, lines 11-26).

Furthermore, as noted previously in Applicant's Brief on Appeal, Wolf does not provide motivation for the use of a hydrophilic swelling material in a primer. In fact, Wolf disclaims the use of "a swelling adhesion treatment" in the context of the invention. "[I]t should be mentioned explicitly that, due to the use of primers according to the

invention, a swelling adhesion treatment of the plastic is not necessary. As a result, the formation of stress cracks is avoided." (Column 4, lines 64-68). Though Wolf is unclear on this issue, even if the prohibition were directed to the substrate only, Applicant maintains that it would not constitute a suggestion to include a swelling material in the primer as the term is used in the Application.

Even assuming, *arguendo*, that a combination of Wolf and Lane would make obvious the claims of the Application, combining the cited references would require exercise of hindsight based on the disclosure of the application. That is not permitted. It is wrong to use applicant's disclosure "as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the results of [applicant's] claims. . . . Monday morning quarterbacking is quite improper when resolving the question of nonobviousness..." *See Orthopedic Equip. Co., Inc. v. United States*, 702 F.2d 1005, 1012, 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983).

In this case, to achieve the result of Applicant's claims through the combination of Wolf and Lane, one must engage in the following reasoning, the motivation for which could only have been found in Applicant's disclosure. First, one must select Cab-o-sil® for use as an anticaking agent based on the disclosure of Lane, even though the disclosure of Lane includes use of an anticaking agent as the less favored of two options, if any anticaking agent is used at all. One must then assume that in Lane the anticaking agent is not separated from the metal salt complexes at any time after grinding.

One must continue to assume that because Lane mentions the use of metal salts and Wolf mentions the use of metal salts (in addition to a number of alternate materials), the use of an anticaking agent would be as beneficial to practicing Wolf as it was to Lane,

even though Wolf makes no mention of an anticaking agent when listing a variety of other optional substances, such as catalysts, emulsifiers, and reaction retarders. (Column 3, lines 11-16). Finally, one must assume that the anticaking agents would remain in the product described by Wolf, and that they would be left in Wolf in the same proportion as described in the Application, leading to a similar effect. Such a series of assumptions could only arise as the result of impermissible hindsight based on the disclosure of the Application.

2. Even if there were motivation to combine the references, the inclusion of the Cab-o-sil® as described in Lane would not inherently lead to the product claimed in the Application.

The office action states that the claims of the Application are obvious because they do nothing more than describe a property that would be inherently present if Cab-o-sil® were used as the anticaking agent of Lane and combined with the disclosure of Wolf. The office action maintains that the Cab-o-sil® would act as a hydrophilic swelling material even if only purposely included as an anticaking agent.

Even assuming that one were motivated to include an anticaking agent in the primer of Wolf, and assuming that the anticaking agent were Cab-o-sil®, there is no guarantee that the Cab-o-sil® would act as the hydrophilic swelling material of the Application. Lane does not disclose how much anticaking agent should be used in the practice of its invention. There is no suggestion of how much anticaking agent one skilled in the art might use when practicing Lane, and no indication that the amount used in Lane would be the same amount used in Wolf if the references were combined. Even if Lane were to disclose the amount of anticaking agent to be used in the practice of that

invention, there is no suggestion in the art that such an amount of anticaking agent would be close to the amount described in the Application. In fact, the only apparent way for one to make sure that the proper amount of anticaking agent were used would be to consult the disclosure of the Application, something that would be an exercise of impermissible hindsight.

Inherency is not established merely because a certain result or characteristic *may* occur. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). Inherency requires that descriptive matter be present in the reference, and that it would be recognized by one of skill in the art. "Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

If Cab-o-sil® were included as an anticaking agent in the invention of Wolf based on the disclosure of Lane, there is no guarantee that the agent would not be present in an amount either far too great or far too small to give the beneficial effects described in the Application. An obviousness rejection based on inherency is therefore inappropriate.

As described above, Claims 1-9 of the Application are not rendered obvious by the disclosure of Wolf in light of Lane. Reconsideration of the Examiner's rejection and allowance of all claims is therefore respectfully requested.

Conclusion

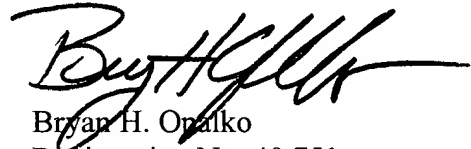
It is respectfully submitted that Applicant's claims illustrate patentable compositions not taught or suggested by any of the art of record. Applicant believes that

the remarks set forth in this paper place this Application in a condition for allowance and such action is respectfully requested at an early date. If the Examiner believes that personal communication will expedite the prosecution of this Application, the Examiner is invited to telephone the undersigned directly.

It is our understanding that no additional fee is required. If that is not the case, the required fees and any insufficiency or overage (except issue fees) may be debited or credited to deposit account 02-4553.

Respectfully submitted,

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